

REMARKS

The Office Action dated June 13, 2007, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-22 and 98 are currently pending in the application, of which claims 1 and 98 are independent claims. Claims 1 and 98 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Entry of the amendments is respectfully requested on the basis of the enclosed Request for Continued Examination (RCE). Claims 1-22 and 98 are respectfully submitted for consideration.

Claims 1, 5-6, 8-10, 12-13, 16, 18-20, 22, and 98 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,721,306 of Farris et al. ("Farris"). Applicant respectfully submits that the claims recite subject matter that is neither disclosed nor suggested by the cited art.

Claim 1, upon which claims 2-22 depend, is directed to a network element between a first internet protocol based network and a second external packet data network. The network includes a first interface configured to communicate with the first internet protocol based network using an internet protocol to receive signals from and send signals to the first network, the first internet protocol based network being a private computer based network comprising wireless capabilities, the interface being configured such that internet protocol traffic intended for a wireless user equipment within the first internet protocol based network from another user equipment within the first network can

occur without any signaling occurring externally of the first network. The network element also includes a second interface configured to communicate with the second network via an internet protocol based connection to receive signals from and send signals to the second packet data network. The network element is configured to determine whether the user equipment is a subscriber of the first network and to make a query to a home location register in the second network when the user equipment is not a subscriber of the first network.

Claim 98 is directed to a network element between a first internet protocol based network and a second external packet data network. The element includes first interface means for communicating with the first internet protocol based network using an internet protocol to receive signals from and send signals to the first network, the first internet protocol based network being a private computer based network comprising wireless capabilities, the interface being configured such that internet protocol traffic intended for a wireless user equipment within the first internet protocol based network from another user equipment within the first network can occur without any signaling occurring externally of the first network. The element also includes second interface means for communicating with the second network via an internet protocol based connection to receive signals from and send signals to the second packet data network. The network element includes means for determining whether the user equipment is a subscriber of the first network and means for making a query to a home location register in the second network when the user equipment is not a subscriber of the first network.

Certain embodiments of the present invention provide a technique for enabling GPRS services to be provided in an office or private network. In particular, in such embodiments there is provided a private network in which user equipment can be located. This private network is provided with wireless facilities so as to enable a standard GPRS phone to connect. Such a phone located within the office environment is able to authenticate using information stored within the office environment, and, if that fails, can be authenticated using information stored in the external GPRS network. Moreover the environment enables communication between two user equipment within the office environment without signaling occurring externally of the network. This firstly reduces costs and secondly the quantity of signaling that needs to occur.

Applicant respectfully submits that Farris fails to disclose or suggest all of the elements of any of the presently pending claims, and consequently cannot provide the critical and unobvious advantages discussed above.

Farris generally relates to a public wireless/cordless internet gateway. More particularly, Farris describes a localized wireless gateway system that provides wireless telephone communication and access to a public packet data network such as the Internet. The network of Farris in itself is self contained. There is no suggestion in Farris that a user equipment within the network of Farris might be the same user equipment that will connect to an external network such as a GPRS network. With reference to column 7, lines 20-24, "the wireless handset is similar to a portable cellular telephone but operates at lower power levels and generally will be less expensive to own and operate." This

clearly indicates that, while a user terminal will be similar to, for example, a GPRS mobile terminal, it is not intended to connect to such a system externally of the private network. It is, therefore, apparent that Farris cannot disclose the feature of the presently pending claims of the present application in which the user terminal may authenticate both internally and externally to the private network.

Thus, for example, Farris does not disclose or suggest, at least, “wherein said network element is configured to determine whether said user equipment is a subscriber of the first network and to make a query to a home location register in said second network when said user equipment is not a subscriber of the first network,” as recited in claim 1, or, at least, “wherein said network element comprises means for determining whether said user equipment is a subscriber of the first network and means for making a query to a home location register in said second network when said user equipment is not a subscriber of the first network,” as recited in claim 98. It is, therefore, respectfully requested that the rejections of claims 1 and 98 be withdrawn.

Claims 5-6, 8-10, 12-13, 16, 18-20, and 22 depend from and further limit claim 1. Each of claims 5-6, 8-10, 12-13, 16, 18-20, and 22, thus, recites subject matter that is neither disclosed nor suggested by Farris. Therefore, it is respectfully requested that the rejections of claims 5-6, 8-10, 12-13, 16, 18-20, and 22 be withdrawn.

Claims 2-4 7, 11, 14-15, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Farris in view of U.S. Patent No. 7,042,855 of Gilchrist et al. (“Gilchrist”). The Office Action took the position that Farris discloses most of the

features of the claims, but cited Gilchrist to remedy certain deficiencies of Farris with respect to the use of a tunneling protocol. Applicant respectfully submits that the claims recite subject matter that is neither disclosed nor suggested by the cited art.

Claims 2-4 7, 11, 14-15, and 17 depend from and further limit claim 1. At least some of the deficiencies of Farris with respect to claim 1 are discussed above. Gilchrist fails to remedy the above-identified deficiencies of Farris, and consequently the combination of Farris and Gilchrist fails to disclose or suggest all of the elements of any of the presently pending claims.

Gilchrist was filed on February 25, 2000, and consequently is not prior art under 35 U.S.C. 102(e) based on its filing date. Applicant notes that a related application to Gilchrist was published as WO 99/50974. For the Examiner's convenience, the following discussion of Gilchrist is provided.

Gilchrist generally relates to a method for routing data in a communication system. More particularly, Gilchrist discusses how a BSS (Base Station System) may be modified to enable a packet destined for a local network be routed directly by the BSS rather than going through the core network. There is no reference in Gilchrist of providing a self contained private network in which the user equipment may authenticate, and, on failing that, authenticate in the external network. It is clear from the description and the associated figures that the GPRS network of Gilchrist is part of the normal GPRS network.

It is, therefore, respectfully submitted that, similar to Farris, Gilchrist is unable to teach the feature in which the user equipment may authenticate both in the internal network and the external network. Since neither of the cited documents disclose the feature by which a user equipment may authenticate with the internal and external networks, it is respectfully submitted that, *prima facie*, the presently claimed invention is non-obvious over the cited art since it cannot be made by a combination of the two documents.

However, Applicant further notes that certain embodiments of the present invention overall can provide an improved internal network that enables a GPRS mobile equipment to connect and transfer data. Importantly, this user equipment may be not merely a dedicated internal device but may authenticate itself with an external network. Farris is only able to teach an internal network with no reference or description of motivation that would lead the person of ordinary skill in the art to provide the more advanced network described in the present application. Gilchrist discusses a technique for localizing routing calls from a GPRS phone to an office network. However, once again, there is no suggestion that separate internal and external networks are provided with a signaling gateway in between.

It is therefore apparent that there is no teaching, motivation, suggestion, or other reason, even when these documents are taken as a whole, to provide the present invention. Thus, it is respectfully requested that the rejection of claims 2-4 7, 11, 14-15, and 17 be withdrawn.

Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Farris in view of U.S. Patent No. 6,570,443 of Vaisanen et al. ("Vaisanen"). Applicant respectfully traverses this rejection.

Vaisanen is patent that was subject to an obligation of assignment to the same entity as the present application, and is only available as prior art, if at all, under 35 U.S.C. 102(e). Accordingly, Vaisanen cannot be used to establish obviousness of any of the presently pending claims, because such usage is barred by 35 U.S.C. 103(c).

Specifically, Vaisanen was subject to an obligation of assignment to Nokia Corporation, as can be seen from line 73 of the cover page of Vaisanen. Likewise, the present application was subject to an obligation of assignment to Nokia Corporation, as can be seen from assignment document recorded on April 10, 2002, at Reel 013038, Frame 0765.

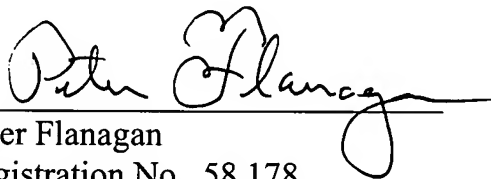
Furthermore, Vaisanen was published May 6, 2003, which is after the U.S. filing date of the present application (April 10, 2002). Thus, 35 U.S.C. 103(c) bars Vaisanen from being used to show obviousness of the present application's claims. Since the rejection cannot stand without Vaisanen, it is respectfully requested that the rejection of Vaisanen be withdrawn.

For the reasons set forth in detail above, it is respectfully submitted that each of claims 1-22 and 98 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-22 and 98 be allowed, and that this application be passed to issuance.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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